



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
--------------------	-------------	-----------------------	------------------

09/145,374 09/01/98 BALL

G 16928-002010
EXAMINER

QM32/0315

JAMES M HESLIN
TOWNSEND AND TOWNSEND AND CREW
EIGHTH FLOOR
TWO EMBARCADERO CENTER
SAN FRANCISCO CA 94111-3834

LAGYK, J ART UNIT PAPER NUMBER

3736
DATE MAILED:

03/15/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 11/29/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-34 is/are pending in the application.
- Of the above, claim(s) 16-19, 29-30 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15, 20-28, 31-34 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2-3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 3736

1. Claims 16-19,29-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 5.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 10 the use of "connectable" is indefinite in that it is unclear whether the second end is connected or not. Also "adapted to" language should be used to avoid claiming a positive connection to the body. In claim 4, lines 12-13 and 17-18, "adapted to" language should be used as discussed above.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2,10-12,14,20,22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lenkauskas '226.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3736

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


6. Claims 4-7,15,21,23-28 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaefer '366 in view of Lenkauskas '226.

Schaefer discloses the claimed device except for the use of connecting members to elastically couple the transducers to the ear. Lenkauskas discloses a similar device and teaches that the use of a spring member (14) that acts as an elastic coupling member. Therefore a modification of Schaefer such that the spring coupling member is used to connect the transducers to the body would have been obvious in view of Lenkauskas which shows that such coupling members are well known. Similarly with claims 23-28 and 31-34 which appear to be other well known hearing devices that include the well known spring coupling member.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is (703) 308-2995.

John P. Lacyk

February 16, 2000


JOHN P. LACYK
PRIMARY EXAMINER